

REMARKS

Claims 1-16 are pending in application as amended and presented. Claims 1 and 4 have been amended and new Claims 15 and 16 are presented in order to more particularly point out and distinctly claim that which Applicants regard as the invention. Support for the newly presented Claims can be found generally throughout the Specification.

By this Office Action, the Examiner has required restriction to one of the following inventions under 35 U.S.C. §121:

- Group I. Claims 1-6, drawn to a method for modulating mechanoreception or mechanosensation in mammal or a method for treating a condition characterized by altered mechanoreception or mechanosensation in a mammal comprising administering to said mammal an effective amount of VR-OAC polypeptide, classified in class 514, subclass 12.
- Group II. Claims 7-8, drawn to a method for modulating mechanoreception or mechanosensation in a mammal comprising introducing to said mammal a nucleic acid vector capable of expressing an effective amount of VR-OAC polypeptide, classified in class 435, subclass 6.
- Group III. Claims 9 (in part), and 10, drawn to a method for determining whether a subject is suffering from altered mechanoreception or mechanosensation, comprising determining expression of VR-OAC polypeptide by detecting the binding of an antibody with VR-OAC polypeptide, classified in class 435, subclass 7.1.
- Group IV. Claims 9 (in part), drawn to a method for determining whether a subject is suffering from altered mechanoreception or mechanosensation, comprising determining the ribonucleic acid capable of encoding VR-OAC polypeptide, classified in class 435, subclass 6.
- Group V. Claims 11 and 12, drawn to a method of screening for modulators of mechanoreception or mechanosensation, classified in class 435, subclass 7.1.

Group VI. Claims 13 and 14, drawn to a biosensor or nanotechnological device, classified in class 436, subclass 807.

Responsive to the Requirement for restriction, Applicants elect to prosecute the invention of Group I, with traverse, Claims 1-6, which are drawn to a method for modulating mechanoreception or mechanosensation in mammal or a method for treating a condition characterized by altered mechanoreception or mechanosensation in a mammal comprising administering to said mammal an effective amount of VR-OAC polypeptide. Applicants have herewith presented new Claims 15 and 16, drawn particularly to methods for modulating mechanoreception or mechanosensation in mammal or a method for treating a condition characterized by altered mechanoreception or mechanosensation in a mammal, which Applicants respectfully request be prosecuted with the elected Group I.

Applicants respectfully request reconsideration of the Requirement for Restriction, or in the alternative, modification of the Restriction Requirement to allow prosecution of more than one group of Claims designated by the Examiner in the present Application, and in particular to allow prosecution of elected Claims 1-6 as amended and newly presented Claims 15 and 16 for the reasons provided as follows.

Under 35 U.S.C. §121 "two or more independent and distinct inventions ... in one Application may ... be restricted to one of the inventions." Inventions are "'independent'" if "there is no disclosed relationship between the two or more subjects disclosed" (MPEP 802.01). The term "'distinct'" means that "two or more subjects as disclosed are related ... but are capable of separate manufacture, use or sale as claimed, AND ARE PATENTABLE OVER EACH OTHER" (MPEP 802.01) (emphasis in original). However, even with patentably distinct inventions, restriction is not required unless one of the following reasons appear (MPEP 808.02):

1. Separate classification
2. Separate status in the art; or
3. Different field of search.

Further, under Patent Office Examining Procedures, "[i]f the Search and Examination of

an entire Application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions" (MPEP 803, Rev. 8, May 1988) (emphasis added).

Applicants respectfully submit that the groups designated by the Examiner fail to define compositions and methods, with properties so distinct as to warrant separate Examination and Search. Claims 7-8 of Group II are drawn to a method for modulating mechanoreception or mechanosensation in a mammal comprising introducing to said mammal a nucleic acid vector capable of expressing an effective amount of VR-OAC polypeptide that are fundamentally related to Claims 1-6 and new Claims 15 and 16 of Group I are drawn to a method for modulating mechanoreception or mechanosensation in mammal or a method for treating a condition characterized by altered mechanoreception or mechanosensation in a mammal comprising administering to said mammal an effective amount of VR-OAC polypeptide. The search for any of the methods separately classified by the Examiner as the invention of Group II would require an additional search of the identical classes wherein the methods of Group I, including new claims 15 and 16, are classified, thus resulting in a duplicate search for the same material. Thus, Applicants submit that the Search and Examination of the entire Application, or, at least, of Group I, including new claims 15 and 16, with Group II can be made without serious burden, and therefore the Examiner must examine all of the claims of the Application on the merits.

The Examiner's assertions to the contrary notwithstanding, Applicants respectfully submit that conjoint examination and inclusion of all of the Claims of the present Application would not present an undue burden on the Examiner, and accordingly, withdrawal of the Requirement for Restriction, or, at the least, modification to include the Claims drawn to Group I and Group II is in order.

No fees are believed to be necessitated by the foregoing Response. However, should this be erroneous, authorization is hereby given to charge Deposit Account No. 11-1153 for any underpayment, or credit any overages.

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In view of the above, withdrawal of the Requirement for the Restriction is requested, and an early action on the merits of the Claims is courteously solicited.

Respectfully submitted,



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Complete Listing of Claims in Application U.S.S.N. 10/027,828

Claim 1 (currently amended): A method for modulating mechanoreception or mechanosensation in a mammal comprising administering to said mammal an effective amount of VR-OAC polypeptide, ~~or~~ active fragments or portions thereof, or a modulator of VR-OAC polypeptide.

Claims 2-3 (original)

Claim 4 (currently amended): A method for treating a condition characterized by altered mechanoreception or mechanosensation in a mammal comprising administering to said mammal an effective amount of VR-OAC polypeptide, ~~or~~ active fragments or portions thereof, or a modulator of VR-OAC polypeptide, wherein said VR-OAC polypeptide comprises the sequence set out in any of SEQ ID NOS: 2, 4, 8 or 9.

Claims 5-6 (original)

Claims 7-14 (withdrawn)

Claim 15 (new) : The method of Claim 1 or 4 wherein said modulator of VR-OAC is selected from substances which mimic, activate or inhibit the activity of VR-OAC.

Claim 16 (new): The method of Claim 1 or 4 wherein said modulator of VR-OAC is an agonist or antagonist of VR-OAC.